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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/380,447	09/01/1999	Sachdev S. Sidhu	P1581R2	2633
23552	7590	09/16/2004	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			TRAN, MY CHAU T	
			ART UNIT	PAPER NUMBER
			1639	

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/380,447

Applicant(s)

SIDHU ET AL.

Examiner

MY-CHAU T TRAN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7-9,11,12,29-33,42,44-49 and 52-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,3,4,7-9,11,12,29-33,42,44-49 and 52-54 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Applicant's amendment filed 6/14/2004 is acknowledged and entered. Claims 34-41, 43, and 50-51 have been canceled. Claim 31 has been amended. Claims 52-54 have been added.
2. Claims 2, 5-6, 10, and 13-28 were canceled; Claims 1, and 11-12 were amended; and Claims 29-51 were added by the amendment filed on 2/26/2004.
3. Claims 1, 3-4, 7-9, 11-12, 29-33, 42, 44-49, and 52-54 are pending.
4. Applicant has elected the following species for the elected invention (Claims 1, 3-4, 7-9, 11-12, 29-33, 42, 44-49, and 52-54) in the reply filed on 4/9/2003 and 7/17/2003:
 - a. A single species of virus (phage) and a single species of coat protein. Applicant elected major coat protein gp VIII of a phage and further elected M13 filamentous phage.
 - b. A single species of amino acid residue and its corresponding position (residue number). *Applicant are further requested to recite the selected coat protein amino acid sequence which read on the elected amino acid residue at the different positions.* Applicant elected a variant of a wild type major coat protein with a substitution at amino acid position 17 of a serine with an isoleucine and elected the following amino acid for each position: Position No./Amino Acid: 1/D, 2/K, 3/S, 4/E, 5/K, 6/F, 7/S, 8/R, 9/D, 11/Y, 12/E, 13/A, 14/L, 15/E, 16/D,

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17/I, 18/I, 19/T, 20/N, 21/L, 22/F, 23/F, 24/L, 25/L, 26/G, 27/T, 28/V, 29/Y,
30/V.

- c. A single species of heterologous polypeptide. Applicant elected an antibody or fragment thereof.

Election/Restrictions

5. The examiner thanks the applicant in clarifying the newly added claims 29-51 with regard to the elected species. Applicant has cancelled claims 34-41, 43, and 50-51, and amended claim 31. It is noted that applicant has indicated that claim 47 is also amended, however in the claim listing it is designated as previously presented and no indication of where the amendment occurs. It is also noted that applicant has elected the sequence of the M13 major coat protein and its sequence, i.e. SEQ ID NO. 2, of claim 31. For clarification, does the sequence of the M13 major coat protein included in the elected sequence of the variant?

6. However upon reconsideration of the additional claims, i.e. claims 29-33, 42, and 44-49, and ***for search purposes*** the elected invention (Claims 1, 3-4, 7-9, 11-12, 29-33, 42, 44-49, and 52-54) is directed to the following patentably distinct species of the claimed invention:

Applicants are requested to elect ***one single*** species from ***each*** of the following a)-d).

- a) A ***single specific*** species of linking peptide, i.e. one "SEQ ID NO." of claim 45.
- b) A ***single specific*** species of target, i.e. claim 47.
- c) If applicant elects human leukocyte surface marker, applicant is further required to elect a ***single specific*** species of human leukocyte surface marker, i.e. claim 48.

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- d) If applicant elects cytokine receptor superfamily receptor, applicant is further required to elect a ***single specific*** species of cytokine receptor superfamily receptor, i.e. claim 49.

The species are distinct, each from the other, because each species of the method step required different reagents and/or producing different products/results that have different chemical structure and/or physiochemical properties and would be capable of separate manufacture and/or use; and would necessitate different and separately burdensome manual and computer bibliographic and structure searches in both patent and non-patent areas.

7. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and ***a listing of all claims readable thereon, including any claims subsequently added.*** An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

8. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

9. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T TRAN whose telephone number is 571-272-0810. The examiner can normally be reached on Mon.: 8:00-2:30; Tues.-Thurs.: 7:30-5:00; Fri.: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW WANG can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct
September 13, 2004



PADMASHRI PONNALURI
PRIMARY EXAMINER